

REMARKS

Status of the Claims

Claims 1-73 and 99-238 remain pending. Claims 28-73, 99-178, and 199-238 have been withdrawn from consideration. Of the remaining pending claims, claims 1-27 and 179-198 were considered in the pending Office Action. Of these considered claims, claim 1 is independent.

In the Office Action, claims 1-27 and 74-98 were rejected under 35 U.S.C. § 101 as being allegedly drawn to non-statutory subject matter. In addition, claims 1-6, 8, 10-16, 19-27, 74-81, 83-98, 179-186, 189, 190, 192, 194-198, 239-247, 249, 250, 252, and 254-258 were rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Marapane et al. (U.S. Patent Application Publication No. 2002/0010556; hereinafter "Marapane"). Also, claims 7, 9, 17, 18, 82, 187, 188, 191, 193, 247, 248, 251, and 253 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Marapane.

In addition, the Examiner has now also rejected claims 1-27 and 74-98 under 35 U.S.C. § 101, alleging that "claims 1-27 and 74-98 are non-statutory since they may be performed within the human mind." Office Action at 2.

Applicant has canceled claims 74-98 and 239-258 without prejudice or disclaimer. Thus, Applicant respectfully requests that the rejections of these claims under 35 U.S.C. §§ 101, 102(e), and 103(a) be withdrawn accordingly.

Rejection Under § 101

The Office Action asserts that in order for a process to qualify as statutory subject matter, and thus, be patent eligible under § 101, the process purportedly must be either (1) tied to another statutory class (such as a particular apparatus) or (2)

transform underlying subject matter (such as an article or materials) to a different state or thing. Office Action at 2. This standard applicable to rejections under 35 U.S.C. § 101 was recently addressed in the Federal Circuit's decision in In re Bilski, No. 2007-1130, slip op. (Fed. Cir. Oct. 30, 2008).

The Office Action rejected claims 1-27 and 74-98 under § 101, alleging that the claims are "non-statutory since they may be performed within the human mind." Office Action at 2. Although Applicant does not necessarily agree with the rejection under § 101, Applicant has made amendments to claim 1 to ensure that claim 1 more clearly qualifies as statutory subject matter. For example, claim 1 now recites a "method for providing hair tinting information via a data processor, comprising: . . . determining, via the data processor, information relating to a plurality of hair tinting products . . . ; [and] . . . determining, via the data processor, information relating to the at least one selected hair tinting product[.]" Emphasis added. These amendments are supported in the specification at, for example, paragraph [010].

Applicant respectfully submits that claim 1, as amended, requires determining steps that are performed "via a data processor," and thus, cannot be "performed in the human mind." Therefore, claim 1 is tied to a particular apparatus, i.e., the recited data processor. Accordingly, Applicant respectfully submits that the § 101 rejection of independent claim 1 should be withdrawn.

Rejection Under 102(e)

Applicant respectfully submits that the claim rejection under Section 102(e) based on Marapane should be withdrawn because Marapane does not disclose all the recitations of independent claim 1. For example, Marapane fails to disclose a method for providing hair tinting information, including, among other features, "providing . . .

information relating to a plurality of hair tinting products" and "receiving third information representative of the subject's selection of at least one hair tinting product in the plurality of hair tinting products," as recited in claim 1. Emphasis added. Rather, Marapane discloses identifying and displaying "achievable end colors from which the recipient will be prompted to select." Page 4, paragraph [0045]; see also Fig. 1, block 180. Further, Marapane discloses prompting a recipient to select from the displayed achievable end colors (paragraphs [0032] and [0045]; block 190), and recommending to the consumer a hair coloring agent based on the consumer's selection at 190 (paragraph [0032]; block 200). Therefore, Marapane discloses displaying a plurality of achievable end colors from which to choose rather than "providing information relating to a plurality of tinting products" from which to choose, as recited in claim 1. Emphasis supplied.

Only after a consumer has selected a desired end hair color (step 190) does Marapane provide any information about a product. See Fig. 12. Marapane appears to only provide information about a single product (that achieves the selected desired end hair color). Id. Thus, Marapane does not provide "information about a plurality of hair tinting products," as recited in claim 1. Emphasis supplied. The Office Action alleges that, because the system of Marapane is disclosed to be utilized in a salon or a retail store that may carry a variety of hair tinting products, and because a beauty counselor may carry out the hair analysis, "the method and system [of Marapane] is fully capable of displaying a plurality of products[.]" Office Action at 14-15, emphasis added. In other words, the Office Action appears to suggest that, because the Marapane system can be used in a salon, the beauty counselor at the salon could provide information about a

plurality of products in the store. However, the Office Action never points to any disclosure in Marapane of such a hypothetical beauty counselor providing/determining information about hair tinting products based on at least “first information representative of at least one state of a subject’s hair” and “second information representative of at least one desired hair tinting result of the subject,” as recited in claim 1. Accordingly, Marapane does not disclose or suggest this claim feature.

In addition, Applicant respectfully submits that Marapane does not inherently disclose such a feature.

To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is **necessarily** present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.”
“Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”

In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) (emphasis supplied) (cited in M.P.E.P. § 2112). Even if a salon or retail store having the Marapane system were to carry a variety of hair tinting products, as alleged, that would not necessitate that the system be configured to display a plurality of products. Since the Marapane system only provides information about a single product based on a user selected color, there would not have been any reason that a beauty counselor would provide information about a plurality of products. That is, since the Marapane system indicates only one product with which a desired color can be achieved, a beauty counselor would not have had any reason to tell the customer about other products in the store (besides the one product displayed by the system) based on the information provided by the system. Further, the amendments to claim 1 further distinguish from Marapane because even if a beauty counselor were to

determine information relating to a plurality of products, such a determination would not be “via a data processor.” Therefore, the allegations in the Office Action regarding the alleged “capab[ility]” of Marapane’s method and system to display a plurality of products fail to support any basis for contending that Marapane provides any inherent disclosure of determining/providing information relating to a plurality of hair tinting products, as required by claim 1.

Marapane’s displaying of “end colors” is not equivalent to displaying “products.” The Office Action contends that “by displaying an ‘end color’ the associated color agent (product) would be displayed or presented, in the event that the method and system is carried out at a salon, to the customer.” Office Action at 15. Applicant respectfully disagrees with this contention. There is no disclosure of determining/providing information relating to a plurality of products, nor is it inherent that such information would be provided, as the system of Marapane does not necessarily provide such information in order to accomplish the disclosed method.

Since these features are not disclosed by Marapane either explicitly or inherently, claim 1 is not anticipated by Marapane. Accordingly, Applicant respectfully submits that the § 102(e) rejection of independent claim 1 should be withdrawn.

Rejection Under § 103(a)

The Office Action asserts that “Applicant’s arguments [with respect to the dependent claims rejected under § 103(a)] fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.” Office Action at 18. Applicant respectfully disagrees. Applicant’s last response pointed out that the cited art lacks disclosure or suggestion of all the

features recited in the independent claims, and that the scope of the dependent claims includes the features recited in the independent claims from which they respectively depend. Applicant's identification of specific claimed features meets the requirements of § 1.111(b).

In the pending Office Action, claims 7, 9, 17, 18, 187, 188, 191, and 193 were rejected under 35 U.S.C. § 103(a) based on Marapane. Each of these claims depends from claim 1 and, thus, incorporates all of the features of claim 1. In light of the above-noted deficiencies of Marapane with respect to claim 1, Marapane fails to disclose all the recitations of claims 7, 9, 17, 18, 187, 188, 191, and 193. Further, one of ordinary skill in the art would not have found any reason in Marapane or any other source to modify Marapane in a manner that would cure the deficiencies noted above with respect to independent claim 1. Additionally, these dependent claims include further limitations that distinguish from the cited art.

For at least these reasons, a prima facie case of obviousness has not been established with respect to claims 7, 9, 17, 18, 187, 188, 191, and 193. Accordingly, Applicant respectfully submits that the § 103(a) rejection of these claims should be withdrawn.

Conclusion

For at least the foregoing reasons, Applicant respectfully submits that independent claim 1 is allowable. In addition, each of claims 2-27 and 179-198 ultimately depends from claim 1 and, therefore, should be allowable for at least the same reasons that claim 1 is allowable.

The Office Action contains characterizations and conclusions regarding the related art and Applicant's claims with which Applicant does not necessarily agree.

Unless expressly noted otherwise, Applicant declines to subscribe to any such characterizations and conclusions.

Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

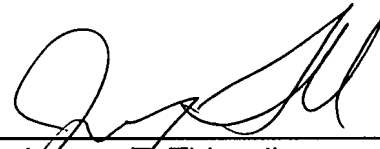
Please grant any additional extensions of time required to enter this response and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 7, 2008

By: _____



Jeremy T. Thissell
Reg. No. 56,065